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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/209,454	12/11/1998	HIDENARI TANAKA	88125/ASAHIN	6958
23548 7590 04/14/2009 LEYDIG VOIT & MAYER, LTD 700 THIRTEENTH ST. NW SUITE 300 WASHINGTON, DC 20005-3960				
EXAMINER				
LASTRA, DANIEL				
ART UNIT		PAPER NUMBER		
3688				
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04/14/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/209,454

Applicant(s)

TANAKA ET AL.

Examiner

DANIEL LASTRA

Art Unit

3688

Period for Reply
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claim 24 has been examined. Application 09/209,454 (METHOD OF SELLING CONTACT LENS) has a filing date 12/11/1998 and foreign priority date 12/12/1997.

Response to Amendment

2. In response to Final Rejection filed 11/17/2008, the Applicant filed an RCE on 02/11/2009, which cancel claims 17-23 and added new claim 24.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pauly et al (U.S. 4,958,280) in view of Eberhardt (U.S. 5,659,741).

Claim 24, Pauly teaches:

A method of selling a prescription contact lens to a contact lens user, the method being implemented in a contact lens selling system, the selling system comprising:

a communication network, first and second group information processing apparatus communicating with each other through the communication network, a memory, and transmitting and receiving means, wherein the first group information processing apparatus is located at a contact

lens seller (see Pauly col 2, line 35 – col 3, line 5; col 3, line 36 – col 4, line 38; col 5, lines 4-18),

the first group information processing apparatus assigns a registration number to the contact lens user based on a contract between the contact lens seller and the contact lens user, the first group information processing apparatus stores the registration number of the contact lens user (see Pauly col 6, lines 39-45),

the first group information processing apparatus transfers the registration number stored to one of an ophthalmologist and an agent of the ophthalmologist (see col 4, lines 50-55),

the second group information processing apparatus is located at the ophthalmologist or the agent of the ophthalmologist (see col 3, lines 35-50),

the second group information processing apparatus receives the registration number from the first group information processing apparatus, the second group information processing apparatus stores ophthalmic diagnosis information for the contact lens user that has been obtained by the ophthalmologist or the agent of the ophthalmologist (see col 9, lines 52-65),

the second group information processing apparatus transfers at least the registration number, date of sale of the contact lens, contact lens information, and the ophthalmic diagnosis information to the first information processing apparatus (see col 4, lines 15-25), the method of selling a prescription contact lens comprising:

assigning the registration number to the contact lens user when information from the contract is input to the first group information processing apparatus, after the

contract has been entered into between the contact lens seller and the contact lens user (see col 9, lines 20-30);

storing the registration number in the memory of the first group information processing apparatus (see col 4, lines 50-55);

transmitting the information from the contract and the registration number from the first information processing apparatus to the second group information processing apparatus through the communication network (see col 4, lines 3-40);

storing the ophthalmic diagnosis information from the second group information processing apparatus in the portable recording medium (see col 9, lines 50-65);

transmitting the date of sale of the contact lens, the contact lens information, and the ophthalmic diagnosis information from the second group information processing apparatus to the first group information processing apparatus through the communication network (see col 9, lines 10-65);

calculation processing means for calculating determining a date for exchanging the contact lens based upon the date of sale of the contact lens, the contact lens information, and the ophthalmic diagnosis information and transferring to the contact lens user information notifying the contact lens user of the date for exchanging the contact lens that has been determined (see col 9, lines 52-67).

Pauly fails to teach each of the first and second group information processing apparatus respectively including means for writing data in a portable recording medium, means for reading the data written in the portable recording medium. However, Eberhardt teaches a portable recording media that stores patient's medical data, such

as prescription information, expiration date, date of purchase, refills and prescription's date of completion (see Eberhardt column 3, lines 39-67; column 4, lines 50-53; column 14, lines 13-36). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly would use a portable recording media, as taught by Eberhardt, to store contact lenses' prescription data. A contact lens customer would present the portable recording media to any contact lens prescriber, that would read the portable recording media and obtain an accurate information about the customer history of lens usage, even when the customer is very ill, unconscious, unable to speak or ignorant about his or her medical history.

Response to Arguments

4. Applicant's arguments filed 02/11/2009 have been fully considered but they are not persuasive. The Applicant argues that Fay does not teach Applicant's claimed invention. The Examiner answers that Fay is not being used to reject the claims in this new Office action.

The Applicant argues that Pauly does not teach Applicant's claimed invention, because according to the Applicant, Pauly does not generate a wear schedule. The Examiner answers that Pauly teaches generating a wear schedule where it recites creating a file containing use and shipment data, including wearing interval (see col 9, lines 60-67) and that patient enrollment includes patient wear cycle and shipping schedule (see col 10, lines 60-67). Therefore, contrary to Applicant's argument, Pauly teaches Applicant's claimed invention.

The Applicant argues that Pauly does not teach Applicant's claimed invention because in Pauly, "wear schedule" simply concerns, according to the Applicant, to passage of time. The Examiner answers that in Pauly, "wear schedule" refers to shipping schedule of contact lenses that a patient would need to receive due to said patient wearing cycle (see col 10, lines 60-67). Therefore, contrary to Applicant's argument, Pauly teaches Applicant's claimed invention.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Examiner, Art Unit 3688
April 10, 2009